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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,015	07/29/2003	Kimberly Kuhlman	CIT.PAU.39	7638
7590	03/02/2005		EXAMINER	
Daniel L. Dawes Myers Dawes Andras & Sherman LLP 11th Floor 19900 MacArthur Boulevard Irvine, CA 92612			NGUYEN, KIET TUAN	
			ART UNIT	PAPER NUMBER
			2881	
DATE MAILED: 03/02/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

A1

Office Action Summary	Application No.	Applicant(s)
	10/629,015	KUHLMAN ET AL.
	Examiner Kiet T. Nguyen	Art Unit 2881

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 10 January 2005.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-6,8-11,13-27,29-30,32-37,39,41 and 42 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-6,8-11,13-27,29-30,32-37,39,41 and 42 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>022705</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

Rejection Under 35 U.S.C. 112, First Paragraph

Claims 1-6, 8-11, 13-18, 25-27, 29-30, 32-37, 39 and 41-42 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The specification is completely for reciting the limitations "mass production" and "without the use of lithography" as recited in claim 1; "semiconductive or insulative specimens (or material)" as recited in claim 25; "mass production", "nonmetallic specimens" and "without the use of any photolithographic step" as recited in claim 29; "mass production" and "semiconductive or insulative specimens" as recited in claim 37; "mass production" and "semiconductive or insulative specimens (or material)" as recited in claim 39; "the mass produced preparation of individual specimens" and "without the use of lithography" as recited in claim 41; and "mass produced specimens" as recited in claim 42. Therefore, the examiner don't understand what is the mass production? What or why are the reasons that the posts are defined without the use of lithography? how is the semiconductive , insulative or nonmetallic probe operated in a probe microscope apparatus for analyzing a sample? What or why are the reasons that the posts are defined without the use of any photolithographic step? Since each limitation (or a single word) recited in claim must be defined in the specification.

Additional explanations are needed if applicant insists on including these features in claims 1-6, 8-11, 13-18, 25-27, 29-30, 32-37, 39 and 41-42.

Clarification without the introduction of new matter is required.

Rejection Under 35 U.S.C. 102(b)

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4, 8, 11, 14-26, 29, 33, 37 and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Larson et al. ("Advances in Atom Probe Specimen Fabrication from Planar Multilayer Thin Film Structures").

Claims 1-4, 8, 11, 14-26, 29, 33, 37 and 39, as the best understood by the meaning of 112, first paragraph above, are rejected as:

Larson et al. disclose, in figs. 1-10, a method for preparation of a specimen for atom probe. The method includes lithographically defining a plurality of posts having prismatic sections in a slab having parallel and intersecting cutting grooves (see fig. 2); removing the posts from the slab (see fig. 3); mounting the post on a metallic pin (see fig. 4); using FIB for shaping the post to a tip shape (see fig. 5); filling an oxide film to serve as an etch stop for lithographic patterning of the posts (see page 26, lines 1-10 in left col.); and fracturing the posts from the slab by a knife or other sharp implement (see page 26, lines 7-11).

Rejection Under 35 U.S.C. 103(a)

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 5-6, 9-10, 13, 27, 30, 32, 34-36 and 41-42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Larson et al. ("Advances in Atom Probe Specimen Fabrication from Planar Multilayer Thin Film Structures").

Claims 5-6, 9-10, 13, 27, 30, 32, 34-36 and 41-42, as the best understood by the meaning of 112, first paragraph above, are rejected as:

Larson et al. disclose all the features as discussed above except cutting intersecting grooves with a saw as recited in claims 5, 13, 27, 32 and 41-42; removing the material by mechanical means as recited in claim 9; removing the material by electrical means as recited in claims 10 and 30; and separating a section having a plurality of posts from the slab as recited in claim 34.

Using the saw, mechanical means or electrical means to cut the intersecting grooves in the slab for defining the posts is considered to be obvious variation in design; since the saw, mechanical means or electrical means is a conventionally equipment used to cut a material (see lines 8-20 of page 12 of the specification and a mechanical cutter 22 in fig. 2 of Ishikawa et al.JP-3266995), thus would have been obvious to one skilled in the art to use the saw, mechanical means or electrical means to cut the specimen in the Larson et al. as Larson et al. disclose lithographically defined silicon post structures (see fig. 2).

Separating a section having a plurality of posts from the slab is considered to be obvious variation in design, since separating the section having a plurality of the posts from the slab and the section having a single post from the slab have the same results for making the atom probes, thus would have been obvious to one skilled in the art to separate the section having a plurality of posts from the slab in the Larson et al. for making the atom probes as Larson et al. disclose making a single probe for each time process.

Applicant's arguments filed on 10 January 2005 have been fully considered but they are not persuasive in view of the foregoing reasons.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

1) Johnson et al. (5,193,595) disclose a saw used to form grooves on a wafer cut specimen (see fig. 4 and claim 5).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kiet T. Nguyen whose telephone number is 571-272-2479. The examiner can normally be reached on Monday-Friday from 8.00 AM to 6.00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John R Lee, can be reached on Monday-Friday. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 2881

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tom

Acting Director
Commissioner of Patents